

REMARKS

I. Introduction

Applicant thanks Examiner Robertson for his courtesy during several telephone calls in February, March, and April of 2009. The substance of the telephone calls is made of record in this Amendment After Final.

In the Final Office Action dated March 16, 2009,¹ the Examiner rejected claims 18, 38-43, 56, and 59 under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Final Office Action also rejected claims 18, 22, 28, and 32-58 under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,151,582 (to Huang et al.) ("Huang") in view of U.S. Patent No. 6,952,680 (to Melby et al.) ("Melby"). In addition, the Final Office Action indicated that claims 60 and 61 would be allowable if rewritten to include all of the limitations of their rejected base claims, and any intervening claims.

By this Amendment After Final, Applicant proposes amending claims 28, 36-38, 44, 50-55, 58, and 61 to clarify aspects of the present invention. No new matter has been added, and claims 18, 22, 28, and 32-61 are currently under examination. In view of the amendments above and the discussion below, Applicant respectfully requests that the amendments be entered, placing pending claims 18, 22, 28, and 32-61 in condition for allowance.

¹ The Final Office Action contains a number of statements reflecting characterizations of the related art and the claims, including but not limited to statements relating to the relative scope of the claims. Regardless of whether any such statement is identified herein, Applicants decline to automatically subscribe to any statement or characterization in the Final Office Action.

II. Section 101 Rejections

The Final Office Action rejected claims 18, 36-43, 56, and 59 under 35 U.S.C. § 101 as allegedly being directed to nonstatutory subject matter. In particular, the Final Office Action alleged that independent claim 38 recited a method that was not “tied to another statutory class of invention (such as a particular apparatus),” nor did the claimed method “transform underlying subject matter to a different state or thing.” Final Office Action at 3.

By this Amendment, Applicant has amended independent claim 38 to recite a method including the step of “receiving at an e-commerce supply chain manager, using a computer, a plurality of notices for recommended maintenance and service.” Claim 38 further recites the step of “receiving at the e-commerce supply chain manager, using a computer, a plurality of requests for maintenance and service from a plurality of service providers.”² A computer is a particular apparatus within the meaning of 35 U.S.C. § 101. The method of amended claim 38 recites such apparatus, and consequently amended claim 38 satisfies the current test for statutory subject matter under 35 U.S.C. § 101. Applicant therefore requests that the Section 101 rejection of claim 38 be withdrawn. Likewise, as claims 18, 39-43, 56, and 59 are dependent upon claim 38, Applicant submits that claims 18, 39-43, 56, and 59 also comply with the requirements of 35 U.S.C. § 101, and asks that the rejections of these claims also be withdrawn.

² For the sake of consistency, similar amendments are proposed by this Amendment After Final to independent claims 44 and 50.

III. Section 103(a) Rejections

The Final Office Action rejected claims 18, 22, 28, and 32-58 under 35 U.S.C. § 103(a) as allegedly being obvious over *Huang* in view of *Melby*. Applicant respectfully traverses these rejections for at least the reason that *Melby* is not valid prior art under 35 U.S.C. §§ 102 or 103(a). The continuation-in-part *Melby* reference is not valid prior art against the present invention because its filing date is not early enough and because its parent application fails to disclose the subject matter relied upon for the rejections. Therefore, a *prima facie* case of obviousness has not been established with respect to claims 18, 22, 28, and 32-58.

A. Continuation-In Part Prior Art

The Final Office Action rejects claims 18, 22, 28, and 32-58 under 35 U.S.C. § 103(a) by applying the *Melby* reference as prior art under 35 U.S.C. § 102(e). As pertinent to this case, 35 U.S.C. § 102(e) provides that “[a] person shall be entitled to a patent unless ... the invention was described in ... an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent” The M.P.E.P. further explains that, “[f]or prior art purposes, a [continuation-in part application is] accorded the earlier filing date [of its parent application] as its prior art date under 35 U.S.C. 102(e), provided the [parent] application properly supports the subject matter relied upon in any rejection in compliance with 35 U.S.C.112, first paragraph. In other words, the subject matter ... must be disclosed in the earlier-filed application in compliance with 35 U.S.C. 112, first paragraph, in order for that subject matter to be entitled to the earlier filing date under

35 U.S.C. 102(e)." M.P.E.P § 2136.04(IV), 8th Ed., Rev. 6 (Sept. 2007) (emphasis added).

B. The Prior Art Date of *Melby*

The *Melby* reference cited in the Final Office Action was filed on October 31, 2000. *Melby* is a continuation-in part of a parent application filed on November 16, 1999. Therefore, under M.P.E.P. § 2136.04(IV), *Melby* can claim a § 102(e) date of November 16, 1999 only if the parent application "properly supports the subject matter relied upon in [the Examiner's] rejection in compliance with 35 U.S.C. 112, first paragraph." Upon comparing *Melby* to its parent application, however, it is clear that several portions of *Melby* cited in the Final Office Action are not supported by the parent application. Consequently, *Melby* is not entitled to a § 102(e) date (or a § 103(a) date) of November 16, 1999.

Melby is directed to a system that monitors and communicates with a plurality of assets, for example a fleet of industrial forklifts, in order to reduce operating costs and administrative burdens. The Final Office Action cited to several portions of *Melby*. For example, the Final Office Action cited Fig. 5, col. 2, ll. 41-67, and the Summary of Invention, especially col. 3, ll. 1-20, with respect to the recitations of claim 38 of "receiving at an e-commerce supply chain manager, using a computer, a plurality of notices for recommended maintenance and service from a plurality of manufacturers," and "receiving at the e-commerce supply chain manager, using a computer, a plurality of requests for maintenance and service from a plurality of service providers." Final Office Action at 7-8.

However, Fig. 5 and the disclosure of col. 3, ll. 1-20 were not included in the parent application of *Melby* that was filed on November 16, 1999. Specifically, the depictions of the “Maintenance organization” and “Analysis Controller Database” from (subsequently added) Fig. 5 were not disclosed in the parent application, nor was the discussion at col. 3, ll. 1-20, which stated that information about industrial assets could be provided to “third parties such as maintenance organizations, asset manufacturers or suppliers, and leasing companies.” Indeed, the disclosure at col. 3, ll. 1-20 makes clear that the discussion of “third parties” was new matter introduced in the continuation-in-part application filed after the filing date of the instant application. See, e.g., col. 3, ll. 1-3 (“*Not only* can the information be provided to an administrative controller, *but it can be* provided to third parties such as maintenance organizations”) (emphasis added). No discussion or drawing similar to these portions of *Melby* exists in the parent application filed November 16, 1999. Nor does the discussion at col. 2, ll. 41-67 disclose the above-mentioned features of claim 38. Col. 2, ll. 41-67 only refers to a “remote analysis system” and an “administrative controller”; it lacks a discussion of “third parties such as maintenance organizations” as discussed in the subsequently added disclosure of col. 3, ll. 1-20.

Likewise, the Final Office Action cites to col. 17, ll. 22-36 of *Melby* with respect to the recitation in claim 38 of “performing maintenance and service through the e-commerce supply chain environment based on the managed schedule.” Final Office Action at 8. As with the portions of *Melby* discussed above, the disclosure from col. 17, ll. 22-36 of *Melby* was not part of the parent application of November 16, 1999. Nor does any other part of the parent application disclose this recitation from claim 38.

Therefore, the rationales under Section 103(a) advanced in the Final Office Action are not supported by the disclosure of the parent application of November 16, 1999. Consequently, *Melby* is not entitled to a prior art date of November 16, 1999 with respect to the present invention.

C. The Priority Date of the Present Invention

The present application was filed on, and hence has a priority date of, November 22, 1999. Because *Melby* cannot claim the prior art date of its parent application with respect to the present invention, it constitutes prior art against the present invention under 35 U.S.C. §§ 102(e) and 103(a) only if it can claim priority to another application filed before November 22, 1999. In the present case, however, *Melby* cannot claim priority to any other application filed before November 22, 1999. Consequently, *Melby* is not prior art under Sections 102(e) or 103(a) with respect to the present invention.

D. The Effect of Priority Upon Obviousness

Because *Melby* is not valid prior art against the present invention under 35 U.S.C. §§ 102(e) or 103(a), it cannot render the present invention obvious. Thus, because the Final Office Action relied upon *Melby* to support the rejection of claims 18, 22, 28, and 32-58 under 35 U.S.C. § 103(a), a *prima facie* case of obviousness has not been established, and Applicant respectfully requests the withdrawal of these rejections.

IV. Conclusions

Applicant appreciatively acknowledges that the Final Office Action indicated that claims 60 and 61 would be allowable if rewritten to include all of the limitations of the base claims and any intervening claims. Final Office Action at 12.

Applicant respectfully requests that this Amendment After Final under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 18, 22, 28, and 32-61 in condition for allowance. Applicant submits that the proposed amendments to claims 28, 36-38, 44, 50-55, 58, and 61 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment After Final should allow for immediate action by the Examiner.

Furthermore, Applicant respectfully points out that the Final Office Action presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entry of this Amendment After Final would allow Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of this Amendment After Final would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment After Final, the Examiner's reconsideration and reexamination of the application, and the timely allowance of claims 18, 22, 28, and 32-61.

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In view of the amendments to the claims and the foregoing remarks, Applicant submits that claims 18, 22, 28, and 32-61 are in condition for allowance. Accordingly, Applicant respectfully requests that these claims be timely allowed.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: May 8, 2009

By: _____

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